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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,700	10/29/2003	Anthony A. McCullough	MAS-10002/22	7539
25006	7590	03/18/2005	EXAMINER	
GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C PO BOX 7021 TROY, MI 48007-7021			MCAVOY, ELLEN M	
			ART UNIT	PAPER NUMBER

1764

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,700

Applicant(s)

MCCULLOUGH ET AL.

Examiner

Ellen M McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20 Jan. 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Claim Rejections - 35 USC § 112

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1, 13 and 22, the terms “polyalkylene glycol”, “polyglycol surfactant” and “polyol surfactant” are not mutually exclusive; the same component may meet the limitations of all three components. A glycol may be a di-ol, and, likewise, a polyglycol may be a polyol. Also, “polyalkylene glycol” is indistinguishable from “polyglycol surfactant”. Clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11, 13, 15-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laemmle (4,452,711) in combination with Schick et al (4,107,060) and/or Bennett (4,925,582).

Laemmle discloses an aqueous metalworking lubricant composition suitable for use in the hot rolling and cold rolling of aluminum which comprises a water-soluble mixture of

polyoxypropylene-polyoxyethylene-polyoxypropylene (PO-EO-PO) block copolymers, a water-soluble carboxylic acid, a water-soluble alkanolamine and water. Laemmle teaches that the block copolymers constitute about 1.0-20 weight % of the lubricant composition. See column 3, lines 20-37. The examiner is of the position that the PO-EO-PO block copolymers meet the limitations of the polyalkylene glycol, polyglycol surfactant and polyol surfactant of the claims. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the composition such as the carboxylic acid component of Laemmle. The water-soluble alkanolamines are set forth in column 4, lines 20-40, and may be added to the lubricant composition in amounts of 0.5-10 weight %. The examiner is of the position that this meets the limitations of the alkanolamine component of the claims. Applicants' invention differs by further adding a biocide and a corrosion inhibitor to the composition. However, Laemmle allows for the addition of conventional additives to the composition such as biocides, oxidation inhibitors and corrosion inhibitors. See column 4, lines 65-68. Several dependent claims add either a benzotriazole salt or at least one morpholine compound to the composition. However, as evidenced by Schick et al ["Schick"] and Bennett, benzotriazole salts and morpholine compounds are well-known as biocides/antimicrobial agents in aqueous fluids which may be used as coolants in metalworking operations. See column 2, lines 25-57, of Schick, and col.3, lines 1-25 of Bennett. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the benzotriazole salt or the morpholine compound to the aqueous metalworking composition of Laemmle if their known imparted property was so desired. The examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the disclosure in Laemmle allowing for the addition of biocides to the composition.

Claim Rejections - 35 USC § 103

Claims 1, 3-9, 11, 13, 15-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biresaw et al (4,781,848) in combination with Schick et al (4,107,060) and/or Bennett (4,925,582)

Biresaw et al ["Biresaw"] discloses a metalworking lubricant composition suitable for use in various metalworking and metal removal operations such as the hot and cold rolling of aluminum which comprises an oil-in-water microemulsion and containing about 1-30 wt.% natural or synthetic oil, about 0.5-30 wt. % of a water-soluble surfactant, about 1-20 wt.% of an organic cosurfactant, and about 45-97.5 wt.% water. The water-soluble surfactant and cosurfactant components include ethoxylated fatty oils and 1,2-alkanediols. See column 3, lines 12-50. The examiner is of the position that these components meet the limitations of the polyalkylene glycol, polyglycol surfactant and polyol surfactant of the claims. Biresaw allows for the addition of water-soluble alkanolamines to the composition. See column 3, line 63 to column 4, top. Applicants' invention differs by further adding a biocide and a corrosion

inhibitor to the composition. However, Biresaw teaches that the lubricant compositions may also contain biocides, oxidation inhibitors, corrosion inhibitors and antifoam agents. See column 4, lines 7-10. Several dependent claims add either a benzotriazole salt or at least one morpholine compound to the composition. However, as evidenced by Schick et al ["Schick"] and Bennett, benzotriazole salts and morpholine compounds are well-known as biocides/antimicrobial agents in aqueous fluids which may be used as coolants in metalworking operations. See column 2, lines 25-57, of Schick, and column 3, lines 1-25 of Bennett. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the benzotriazole salt and/or the morpholine compound to the aqueous metalworking composition of Biresaw if their known imparted property was so desired. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the disclosure in Biresaw allowing for the addition of biocides to the composition.

Conclusion

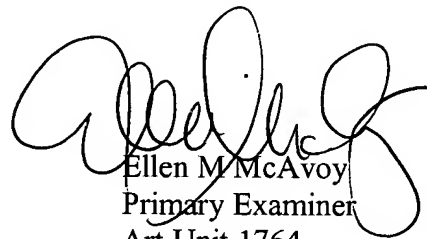
The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Art Unit: 1764

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
March 14, 2005